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GP 3731

Practitioner's Docket No. A31-4000 **PATENT**

OIPE JC86 FEB 22 2000 PATENT & TRADEMARK OFFICE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Match & Return

In re application of: Thomas W. Davison et al.

Serial No.: 09/137,335 Group No.: 3731

Filed: August 20, 1998 Examiner: W. Lewis

For: CANNULA FOR RECEIVING SURGICAL INSTRUMENTS

RECEIVED FEB 28 2000 TECHNOLOGY CENTER 3700

NOTE: "In addition to identifying the application number of the prior application, applicant should furnish in the request for an application under this paragraph the following information relating to the prior application to the best of his or her ability: (i) Title of Invention; (ii) Name of applicant(s); and (iii) Correspondence address." 37 C.F.R. § 1.53(d)(8).

Box CPA
Commissioner of Patents and Trademarks
Washington, D.C. 20231

CONTINUED PROSECUTION APPLICATION (CPA)
(37 C.F.R. § 1.53(d))

NOTE: A continued prosecution application can only ~~be filed~~ for a divisional or continuation of a prior nonprovisional application and can NOT be filed for a continuation-in-part application. 37 C.F.R. § 1.53(d)(1).

NOTE: Facsimile transmission can be used to obtain a date of transmission for this correspondence. 37 C.F.R. § 1.8(b)(3).

WARNING: *A continued prosecution application "is a request to expressly abandon the prior application" as of its filing date. 37 C.F.R. § 1.53(d)(2)(v).*

WARNING: *While the filing of a continued prosecution application is the specific reference required by 35 U.S.C. § 120 to every application assigned the application number, identified in such request, no amendment in the application may delete the specific reference to any prior application (e.g., for patent term purposes). 37 C.F.R. § 1.53(d)(7).*

CERTIFICATION UNDER 37 CFR 1.8(a) and 1.10
(When using Express Mail, the Express Mail label number is mandatory; Express Mail certification is optional.)

I hereby certify that, on the date shown below, this correspondence is being:

MAILING

☒ deposited with the United States Postal Service in an envelope addressed to the Commissioner for Patents and Trademarks Washington, D.C. 20231

37 C.F.R. § 1.8(a)

☐ with sufficient postage as first class mail.

37 C.F.R. § 1.10*

☒ as "Express Mail Post Office to Addressee" Mailing Label No. EK421338069US **(mandatory)**

TRANSMISSION

☐ transmitted by facsimile to the Patent and Trademark Office.

Teresa Ragone

Signature

Date: February 22, 2000

TERESA RAGONE
(type or print name of person certifying)

02/24/2000 TLUU11 00000025 09137335
01 FC:231 345.00 OP
02 FC:203 18.00 OP
03 FC:202 156.00 OP

1. This is a request for the filing of a

☒ continuation

☐ divisional

continued prosecution application under 37 C.F.R. § 1.53(d) of the above-identified prior nonprovisional application.

☒ This continued prosecution application is being filed to permit consideration of an Information Disclosure Statement under 37 C.F.R. § 1.97.

☒ An Information Disclosure Statement is enclosed and includes:

☒ PTO-1449,

☒ Copies of Information Disclosure Statement Citations.

It is further requested that this continued prosecution application utilize the file jacket and contents of the prior application, including the specification, drawings, and oath or declaration from the prior application, to constitute this new application, and that the application number of the above-identified prior application be assigned for identification purposes. 37 C.F.R. § 1.53(d)(2)(iv).

It is also requested that the above-identified application be expressly abandoned as of the filing date accorded this continued prosecution application. C.F.R. § 1.53(d)(2)(v).

2. With respect to the above-identified nonprovisional application, this continued prosecution application is being filed:

A. ☒ before the earliest of the:

☐ termination of the proceedings on the prior application (37 C.F.R. § 1.53(d)(1)(ii)(C).

☒ payment of the issue fee thereon (37 C.F.R. § 1.53(d)(1)(ii)(A).

☐ abandonment of the prior application (37 C.F.R. § 1.53(d)(1)(ii)(B).

OR

B. ☐ after the payment of the issue fee – but a petition under § 1.313(b)(5) has been granted in the prior application. 37 C.F.R. § 1.53(d)(1)(ii)(A).

C. The term for response or taking action in the prior application expires on

March 20, 2000.

☐ An extension of time in the prior application is:

☐ filed concurrently in the prior application

☐ has been filed on _____

3. It is noted that:

- This application discloses and claims only subject matter disclosed in the prior application. 37 C.F.R. § 1.53(d)(2)(ii).
- Filing of this continued prosecution application is to be construed to include a waiver of confidentiality by the applicant under 35 U.S.C. § 122, to the extent that any member of the public, who is entitled under the provisions of § 1.14 to access to, copies of, or information concerning, either the prior application or any continuing application filed under the provisions of 37 C.F.R. § 1.53(d), may be given similar access to, copies of, or similar information concerning the other application or applications in the file jacket. 37 C.F.R. § 1.53(d)(6).
- Filing of this request is the specific reference required by 35 U.S.C. § 120 to every application assigned the application number identified in this request. No amendment in this application may delete this specific reference to any prior application. 37 C.F.R. § 1.53(d)(7) and 1.78(a)(2).

4. This continued prosecution application names as inventors:

☒ the same inventors named in the prior application on the date this continued prosecution application under 37 C.F.R. § 1.53(d) is being filed. 37 C.F.R. § 1.53(d)(4).

☐ inventors fewer than all the inventors named in the prior application. 37 C.F.R. § 1.53(d).

☐ Please delete the following name(s) as inventor(s):

NOTE: No person may be named as an inventor in an application filed under this paragraph who was not named as an inventor in the prior application on the date the application under this paragraph was filed, except by way of a petition under § 1.48." 37 C.F.R. § 1.53(d)(4).

5. ☐ Attached hereto is an amendment to the prior application as it existed prior to the filing of this continuation prosecution application.

☐ Enter the unentered amendment previously filed on _____

under 37 C.F.R. § 1.116 in the prior application (copy enclosed).

☐ A preliminary amendment is enclosed.

NOTE: "Any new change must be made in the form of an amendment to the prior application as it existed prior to the filing of an application under this paragraph. No amendment in an application under this paragraph (a continued prosecution application) may introduce new matter or matter that would have been new matter in the prior application. Any new specification filed with the request for an application under this paragraph will not be considered part of the original application papers, but will be treated as a substitute specification in accordance with § 1.125" 37 C.F.R. § 1.53(d)(5).

6. Fee Calculation

NOTE: *"(3) The filing fee for a continued prosecution application filed under this paragraph is:*

(i) The basic filing fee as set forth in § 1.16; and

(ii) Any additional § 1.16 fee due based on the number of claims remaining in the application after entry of any amendment accompanying the request for an application under this paragraph and entry of any amendments under § 1.116 unentered in the prior application which applicant has requested to be entered in the continued prosecution application."

37 C.F.R. § 1.53(d)(3)(i) and (ii).

A. ☒ Regular Application

CLAIMS AS FILED			
Number filed	Number Extra	Rate	**Basic Fee Small Entity** 37 C.F.R. § 1.16(a) $ 345.00
Total Claims (37 C.F.R. § 1.16(c))	22-20= 2	X $ 9.00=	18.00
Independent Claims (37 C.F.R. § 1.16(b))	7- 3= 4	X $ 39.00=	156.00
Multiple dependent Claim(s) if any (37 C.F.R. § 1.16(d)) +	0	$270.00= 0	

☐ An amendment canceling extra claims is enclosed.

☐ An amendment deleting multiple-dependencies is enclosed.

☐ The fee for extra claims is not being paid at this time.

NOTE: If the fees for extra claims are not paid on filing, they must be paid or the claims canceled by amendment, prior to the expiration of the time period set for response by the Patent and Trademark Office in any notice of fee deficiency. 37 C.F.R. § 1.16(d).

Filing Fee Calculation **$519.00**

B. ☐ Design Application

($330.00)—37 C.F.R. § 1.16(f))

Filing Fee Calculation $_____

C. ☐ Plant Application

($540.00)—37 C.F.R. § 1.16(g))

Filing Fee Calculation $_____

7. Small Entity Statement(s)

☒ Statement(s) that this is a filing by a small entity under 37 C.F.R. §§ 1.9 and 1.27 is (are) attached.

WARNING: *". . .Status as a small entity in one application or patent does not affect any other application or patent, including applications or patents which are directly or indirectly dependent upon the application or patent in which the status has been established. The refiling of an application under § 1.53 as a continuation, division, or continuation-in-part (including a continued prosecution application under § 1.53(d)), or the filing of a reissue application requires a new determination as to continued entitlement to small entity status for continuing or reissue application. A nonprovisional application claiming benefit under 35 U.S.C. 119(e), 120, 121 or 365(c) of a prior application, or a reissue application may rely on a statement filed in the prior application or in the patent if the nonprovisional application or the reissue application includes a reference to the statement in the prior application or in the patent or includes a copy of the statement in the prior application or in the patent if status as a small entity is still proper and desired. . . ." 37 C.F.R. § § 1.28(a)(2).*

(complete the following, if applicable)

☒ Status as a small entity was claimed in prior application

Serial No. 09/137,335, filed on August 20, 1998, from which benefit is being claimed for this application under:

35 U.S.C. § ☐ 119(e)

☒ 120,

☐ 121,

☐ 365(c),

and which status as a small entity is still proper and desired.

☒ A copy of the statement in the prior application is included.

NOTE: Any excess of the full fee paid will be refunded if a small entity statement and a refund request are filed within 2 months of the date of timely payment of a full fee. The two-month period is not extendable under § 1.136. 37 C.F.R. § 1.28(a).

8. Fee Payment Being Made at This Time

☐ Not Enclosed

☐ No filing fee is to be paid at this time.

(This and the surcharge required by 37 C.F.R. § 1.16(e) can be paid subsequently.)

☒ Enclosed

☒ Filing Fee	$519.00
☐ Recording assignment ($40.00—37 C.F.R. § 1.21(h)) (See attached "COVER SHEET FOR ASSIGNMENT ACCOMPANYING NEW APPLICATION.")	$
☐ Petition fee for filing by other than all the inventors or person or behalf of the inventor where inventor refused to sign or cannot be reached ($130.00—37 C.F.R. §§ 1.47 and 1.17(ii)	$
Total fees enclosed	**$519.00**

9. Method of Payment of Fees

☒ Check in the amount of $519.00

☐ Charge Account No. 20-0090 in the amount of $ _____

A duplicate of this transmittal is attached.

NOTE: Fees should be itemized in such a manner that it is clear for which purpose the fees are paid. 37 C.F.R. § 1.22(b).

WARNING: *Unless an application under § 1.53(d) filed by facsimile includes an authorization to charge the basic filing fee to a deposit account, the applicant will be given a notification requiring payment of the appropriate filing fee (§ 1.53(d)(3) and the late filing surcharge under § 1.16(e) to avoid abandonment of the § 1.53(d) application. 62 Fed. Reg. 53,131, 53,133 (Oct. 10, 1997).*

10. Authorization to Charge Additional Fees

WARNING: *If no fees are to be paid on filing, the following items should not be completed.*

WARNING: *Accurately count claims, especially multiple dependent claims, to avoid unexpected high charges, if extra claim charges are authorized.*

☒ The Commissioner is hereby authorized to charge the following additional fees by this paper and during the entire pendency of this application to Account No. 20-0090.

☒ 37 C.F.R. §§ 1.16(a), (f), or (g) (filing fees)

☒ 37 C.F.R. §§ 1.16(b), (c), and (d) (presentation of extra claims)

NOTE: *Because additional fees for excess or multiple dependent claims not paid on filing or on later presentation must only be paid or these claims canceled by amendment prior to the expiration of the time period set for response by the P.T.O. in any notice of fee deficiency (37 C.F.R. § 1.16(d)), it might be best not to authorize the P.T.O. to charge additional claim fees, except possibly when dealing with amendments after final action.*

☐ 37 C.F.R.§ 1.16(e)(surcharge for filing the basic filing fee and/or declaration on a date later than the filing date of the application)

☒ 37 C.F.R. §§ 1.17(a)(1)--(5)(extension fees pursuant to § 1.136(a))

☐ 37 C.F.R. § 1.17 (application processing fees)

WARNING: "A written request may be submitted in an application that is an authorization to treat any concurrent or future reply, requiring a petition for an extension of time under this paragraph for its timely submission, as incorporating a petition for extension of time for the appropriate length of time. An authorization to charge all required fees, fees under § 1.17, or all required extension of time fees will be treated as a constructive petition for an extension of time in any concurrent or future reply requiring a petition for an extension of time under this paragraph for its timely submission. Submission of the fee set forth in § 1.17(a) will also be treated as a constructive petition for an extension of time in any concurrent reply requiring a petition for an extension of time under this paragraph for its timely submission." 37 C.F.R. § 1.136(a)(3).

☐ 37 C.F.R. § 1.18 (issue fee at or before mailing of Notice of Allowance, pursuant to 37 C.F.R. § 1.311(b)).

NOTE: Where an authorization to charge the issue fee to a deposit account has been filed before the mailing of a Notice of Allowance, the issue fee will be automatically charged to the deposit account at the time of mailing the Notice of Allowance. 37 C.F.R. § 1.311(b).

NOTE: 37 C.F.R. § 1.28(b) requires "Notification of any change in status resulting in loss of entitlement to small entity status must be filed in the application. . . prior to paying, or at the time of paying, . . . issue fee. From the wording of 37 C.F.R. § 1.28(b), (a) notification of change of status must be made even if the fee is paid as "other than a small entity" and (b) no notification is required if the change is to another small entity.

11. Instructions as to Overpayment

NOTE: "Amounts of twenty-five dollars or less will not be returned unless specifically requested within a reasonable time, nor will the payer be notified of such amounts; amounts over twenty-five dollars may be returned by check or, if requested, by credit to a deposit account." 37 C.F.R. § 1.26(a).

☐ Credit Account No. 20-0090

☒ Refund

Date: February 22, 2000

SIGNATURE OF PRACTITIONER

Reg. No. 20,177

Thomas L. Tarolli
(type or print name of practitioner)

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